



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/158,310	06/10/2011	Benjamin CHOU	BC-0001	9126

109174 7590 01/23/2018
Ledell Ansari, LLP
211 North Union St.
Suite 100
Alexandria, VA 22314

EXAMINER

SHAAWAT, MUSSA A

ART UNIT	PAPER NUMBER
----------	--------------

3665

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

01/23/2018

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@ledellansari.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BENJAMIN CHOU

Appeal 2017-002892
Application 13/158,310
Technology Center 3600

Before MICHAEL J. STRAUSS, AARON W. MOORE, and
DAVID J. CUTITTA II, *Administrative Patent Judges*.

CUTITTA, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

I. STATEMENT OF THE CASE

Appellant filed a request for rehearing on November 7, 2017 (hereinafter “Rehearing Request” or “Reh’g Req.”) under 37 C.F.R. § 41.52, seeking reconsideration of our Decision, mailed September 8, 2017 (hereinafter “Decision” or “Dec.”), which affirmed the Examiner’s final rejection of claims 1–3, 5–7, 10–14, 21, 22, and 24–28 under 35 U.S.C. § 101. We have jurisdiction over the Rehearing Request under 35 U.S.C. § 6(b).

We have reconsidered our Decision regarding the claims in light of Appellant's comments in the Request. Reh'g Req. 2–7. We grant the Rehearing Request to the extent that we consider Appellant's arguments *infra*, but DENY the request to modify our Decision. We incorporate our earlier Decision herein by reference. *See* 37 C.F.R. § 41.52(a)(1).

II. BACKGROUND

As an initial matter, we note that a request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the [Patent Trial and Appeal Board (the “Board”)].” 37 C.F.R. § 41.52(a). A request for rehearing is not an opportunity to rehash arguments raised in the briefs. Neither is it an opportunity to merely express disagreement with a decision without setting forth the points believed to have been misapprehended or overlooked. Accordingly, the proper course for an appellant dissatisfied with a Board decision is to seek judicial review, not to file a request for rehearing to reargue issues that already have been decided. *See* 35 U.S.C. §§ 141, 145.

III. ANALYSIS

Appellant argues that the rationale for affirming the rejection of claim 10 “does not appear to address the actual features of claim 10, nor the arguments presented in Appellant's Appeal Brief or Reply Brief.” Reh'g Req. 2. Specifically, Appellant argues “the features of claim 10 are not capable of being performed by human thought alone, or by pen and paper.” Reh'g Req. 4. As evidence, Appellant provides a hypothetical example in which “a human performing this process would incorrectly recognize one of

the numbers.” *Id.* at 5. Appellant further argues “[a]ssuming that it is reasonable to assert that a human performing this process would incorrectly recognize one of the numbers, Appellant submits that it is unclear how or why a human would perform the process” and, thus, “the process recited in claim 10 could not be ‘performed by human thought alone or by pen and paper.’” *Id.*

We are not persuaded that Appellant’s hypothetical example in which a human may incorrectly recognize one of the numbers demonstrates “the features of claim 10 are not capable of being performed by human thought alone, or by pen and paper.” *Id.* at 4. As noted in the Decision, claim 10 includes the limitation “highlighting, by the computer, a particular area of the image data, the particular area being associated with a financial transaction that corresponds to the selected particular cell.” Apart from the recitation of a generic computer, we determine this limitation is capable of being performed by human thought alone, or by pen and paper. A method that can be performed by human thought alone or by pen and paper is merely an abstract idea and is not patent-eligible under § 101. *Versata Development Group, Inc. v. SAP America, Inc.*, 793 F.3d 1306, 1335 (Fed. Cir. 2015) (citing *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011)). Furthermore, relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent eligible.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015), *cited in* Ans. 3. So, even if a computer performs the claimed method with fewer errors than a human, using a computer to perform the argued process does not supply an inventive concept.

Inquiry therefore must turn to any requirements in the claim for *how* the desired result is achieved. But in this case the claim’s invocation of a generic computer does not transform the claimed subject matter into a patent-eligible application. The claim at issue does not require any nonconventional computer or display components, or even a “non-conventional and non-generic arrangement of known, conventional pieces,” but merely calls for performance of the claimed information collection, analysis, and display functions “on a set of generic computer components” and display devices. *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349–52 (Fed. Cir. 2016)

Appellant next argues “an analysis under *McRo* further supports Appellant’s position that claim 10 is directed to patent-eligible subject matter” because “[h]ere, the automated process in claim 10 (e.g., the highlighting of a portion of an image when a corresponding data is selected in a datasheet) is performed differently from any ‘conventional’ practice of which Appellant is aware.” Reh’g Req. 5. Appellant, thus, concludes that “the features of claim 10 are not ‘well-understood, routine, and conventional activities previously known to the pertinent industry.’” Reh’g Req. 6.

We disagree. We see no reason on the record to either accept or question Appellant’s assertion that the claimed document processing method is a valuable improvement over known document processing methods. However, the fact that a claimed concept is “[g]roundbreaking, innovative, or even brilliant” does not “itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013). A claim directed to a unique and advantageous method that can be performed by human thought alone or by pen and paper nonetheless

constitutes an abstract idea. “[U]nder the *Mayo/Alice* framework, a claim directed to a newly discovered law of nature (or natural phenomenon or abstract idea) cannot rely on the novelty of that discovery for the inventive concept necessary for patent eligibility.” *Genetic Techs. Ltd. v. Merial L.L.C.*, 818 F.3d 1369, 1376 (Fed. Cir. 2016); *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981).

Furthermore, Appellant’s reliance upon *McRO* is misplaced. (See Request 3–4.) In *McRO*, the Federal Circuit held that “claim 1 is directed to a patentable, technological improvement over the existing, manual **3-D animation techniques**” and “therefore, is not directed to an abstract idea.” *McRO* at 1316 (emphasis added). In reaching this determination, the Federal Circuit expressly distinguished 3-D animation steps from those involved in “organizing [existing] information into a new form.” *Id.* at 1315.

Here, claim 10 is directed to organizing existing information into a new form such as by highlighting a particular area of the image data (see Decision 11), which immediately sets the claim apart from the claim considered by the Federal Circuit in *McRO*. In the Request, Appellant does not point with particularity to, and we do not see, any feature recited in claim 10 that carries out a function unrelated to the identified abstract idea. Rather, we find Appellant’s claim 10 bears a substantial similarity to the analyzed claim 12 that the Federal Circuit determined was patent ineligible in *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350 (Fed. Cir. 2016). Under the first step of *Alice*, the Federal Circuit in *Electric Power Group* stated that

The claims in this case fall into a familiar class of claims “directed to” a patent-ineligible concept. The focus of the asserted claims, as illustrated by claim 12 . . . , is on collecting

information, analyzing it, and displaying certain results of the collection and analysis. We need not define the outer limits of “abstract idea,” or at this stage exclude the possibility that any particular inventive means are to be found somewhere in the claims, to conclude that these claims focus on an abstract idea—and hence require stage-two analysis under §101.

Id. at 1353. Similar to claim 12 in *Electric Power Group*, Appellant’s claim 10 involves collecting data from paper financial documents, analyzing the data, and displaying results, the claim requiring no more than displaying the results of abstract processes of collecting and analyzing information which is abstract as an ancillary part of such collection and analysis. *See, e.g., Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). As such, claim 10 is “clearly focused on the combination of those abstract-idea processes” and “[t]he advance [it purports] to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions.” *Elec. Power Grp.*, 830 F.3d at 1354.

Accordingly, we are not persuaded of any basis for modifying the Decision in light of the Rehearing Request.

REHEARING DECISION

While we have considered the Decision in light of the Request for Rehearing, we decline to modify it in any respect.

Appeal 2017-002892
Application 13/158,310

Pursuant to 37 C.F.R. § 41.52(a)(1), this decision is final for the purpose of judicial review. A party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

DENIED